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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,961	12/06/2001	Chien-Min Sung	20236	5672
20551	7590	07/13/2005	EXAMINER	
THORPE NORTH & WESTERN, LLP. 8180 SOUTH 700 EAST, SUITE 200 P.O. BOX 1219 SANDY, UT 84070			ROSE, ROBERT A	
			ART UNIT	PAPER NUMBER
			3723	

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/010,961

Applicant(s)

SUNG, CHIEN-MIN

Examiner

Robert Rose

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
4a) Of the above claim(s) 27-53 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-26 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 27-53 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made without traverse in Paper No. 6.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-2, 5-7, and 10-16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Billett. Billett discloses a dressing tool comprising all of the subject matter set forth in applicant's claims above. Note stainless steel or carbide substrate coated with a polycrystalline diamond layer having an array of projections. The dressing tool of Billett appears fully capable of conditioning a fixed abrasive pad. Note at column 4, lines 45-56 that the diamond layer in Billett may be "about 20 microns" in at least one embodiment, which meets the limitation of the projections having a height "equal to or less than about 30 micrometers".

4. Claims 1-26 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Myoung et al(US 6439986). Myoung et al discloses a dressing tool comprising all of the subject matter of applicant's claims above. Note various embodiments of dressing tool comprising a substrate of ceramic or metallic material with a pattern of projections coated with a carbonaceous layer of

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diamond. With regard to claim 2 the height of the poles on an intended workpiece is not limiting on the apparatus. The dressing tool of Myoung et al appears fully capable of conditioning a fixed abrasive pad. Note at column 11, lines 36-46 that the smaller rectangular protrusions(40') are of a height dimension of about 30 micrometers which meets the limitation of the projections having a height "equal to or less than about 30 micrometers".

5. Applicant's arguments filed April 25, 2005 have been fully considered but they are not persuasive. With regard to Applicant's additional limitation in claims 1, 19, and 23 the references to Billett and Myoung et al are deemed to disclose the limitation with respect to protrusion height, as broadly stated. Note the passages specifically mentioned in the above rejections. Applicant's arguments that Billett and Myoung are not from the same field of endeavor, center around the point that the conditioning tools of both Billett and Myoung et al are intended for conditioning non-fixed abrasive polishing pads, which are of a different material than the fixed abrasive pads. However, the conditioning tools of Billett and Myoung et al are not limited in their use. In view of the fact that these references are applied against apparatus claims, they are still deemed to structurally meet the limitations as broadly set forth. With regard to the new limitation in claims 1, 19, and 23 of "the small projections having a size that is sufficient to condition the fixed abrasive pad ...", such language is a statement of intended use, which is not structurally limiting on the conditioning tool, per se. Further, it appears that the tools of both Billett and Myoung et al are fully capable of being used for the purpose of conditioning fixed abrasive pads, since there is no structure therein which would preclude such use.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication should be directed to Robert Rose at telephone number (571) 272-4494.

rr

July 8, 2005.

A handwritten signature in black ink, appearing to read "Robert A. Rose".

**ROBERT A. ROSE
PRIMARY EXAMINER
ART UNIT 323**

11/11/05